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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,168	03/27/2001	Michael A. Munoz	P-5744	1917
28465	7590	07/18/2005	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US LLP P. O. BOX 64807 CHICAGO, IL 60664-0807			GOTTSCALK, MARTIN A	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,168

Applicant(s)

MUNOZ ET AL.

Examiner

Martin A. Gottschalk

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7,22 and 23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,7,22 and 23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 07 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-7, 22, and 23 in the reply filed on 6/6/2005 is acknowledged.
2. This application contains claims 8-21, 24, and 25, drawn to inventions nonelected in the reply filed on 6/6/2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Notice to Applicant

3. Claims 1-7, and 22 and 23 have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3626

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-7, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobylevsky et al. (US Pat# 6,493,427, hereinafter Kobylevsky) in view of Goetz et al (US Pat# 6,421,650, hereinafter Goetz).

A. As per claim 1, Kobylevsky discloses method of processing a prescription refill request via an interactive voice response system (Kobylevsky: abstract), the method comprising the steps of:

(a) providing access to an interactive response system (Kobylevsky: col 2, Ins 53-56; Fig. 1);

(b) prompting for a pharmacy identification (Kobylevsky: Fig. 2, note the field marked "Pharmacy Name"; and

(c) prompting for a patient identification (Kobylevsky: col 7, Ins 35-42; col 25, Ins 4-5).

Kobylevsky fails to disclose the step of

(d) prompting for an NDC number of a medication corresponding to the prescription to be filled.

However, this feature is well known in the art as evidenced by the teachings of Goetz:

Art Unit: 3626

Goetz teaches a health care provider inputting an NDC number corresponding to the prescription to be filled to supply necessary information about the medication to the patient (Goetz: col 6, Ins 1-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Goetz within the method of Kobylevsky in order to provide patients easy access to complete medical information on a prescription (Goetz: col 1, Ins 64-67).

B. As per claim 2, Kobylevsky discloses the method of claim 1, further comprising the step of

providing an authorization for the requested refill (Kobylevsky: col 7, Ins 39-42; col 29, Ins 9-22;).

C. As per claim 3, Kobylevsky discloses the method of claim 1, further comprising the steps of:

confirming the pharmacy identification (Kobylevsky: Fig. 2, note the field marked "Pharmacy Name"; col 25, Ins 36-39; the Examiner considers the step of entering the pharmacy's name into the computer after typing it into the provided data entry field be a form of confirming the pharmacy identification.);

confirming the patient identification (Kobylevsky: col 7, Ins 35-42. Note the prompting for "...patient full name and phone number...". The Examiner considers requiring these two separate pieces of information to be a form of confirming the patient identification); and

Art Unit: 3626

confirming the medication (Kobylevsky: col 25, 12-23. The Examiner considers entering the Rx number into the system followed by playback to the customer to be a form of confirming the medication.)

D. As per claim 4, Kobylevsky discloses the method of claim 1, further comprising the steps of:

prompting for the date the prescription was last filled (Kobylevsky: col 7, Ins 57-61. The Examiner being required to enter the Rx number to be a form of prompting for the date the prescription was last filled, since the Rx number will have this date associated with it.);

prompting for the identification of the original prescribing physician (Kobylevsky: col 7, Ins 35-42, reads on "...state their full name and phone number..."); and

prompting for the quantity of the medication (Kobylevsky: col 7, Ins 40-42, reads on "...all relevant information for the...refill authorization...". Also col 7, Ins 57-61. The Examiner being required to enter the Rx number to be a form of prompting for the quantity of the medication, since the Rx number will include the quantity.).

E. As per claim 5, Kobylevsky discloses the method of claim 1, wherein each response to a prompt is followed by a confirmation of the response (rejected as per the reasons provided for claim 3 above); and

Art Unit: 3626

the prescription refill request is assigned a unique tracking identification (Kobylevsky: col 25, 12-23. The Examiner considers the Rx number to be a unique tracking number).

F. As per claim 6, Kobylevsky discloses the method of claim 1, further comprising the steps of:

creating a database entry for each prescription refill request (Kobylevsky: col 24, lns 6-20 and 59-61).

However, Kobylevsky fails to explicitly disclose the method of claim 1, where the database entry for each prescription refill includes:

the NDC identification and a corresponding commercial or generic name of the medication corresponding to the NDC identification, whereby a physician or individual may consider and provide the refill authorization based on the commercial or generic name of the medication.

However, these features are well known in the art as evidenced by the teachings of Goetz.

Goetz teaches a relational database which includes drug names and their corresponding NDC numbers (Goetz: col 15, lns 32-37; Fig. 44, note in particular the fields labeled "Drug" and "NDC"). Fig. 44, item 212 in particular shows a step where a physician or individual might consider this information.

The motivation to combine the teachings of Goetz within the method of Kobylevsky are the same as provided for claim 1 and is incorporated herein.

Art Unit: 3626

G. As per claim 7, Kobylevsky discloses the method of claim 6, further comprising the steps of:

providing a physician or other user access to the database entry

(Kobylevsky: col 29, lns 18-31);

prompting the physician or other user to enter comments (Kobylevsky: col 7, lns 42-45);

prompting the physician or other user to indicate approval of the request (Kobylevsky: col 7, lns 36-42, reads on "...prompted by the system to...<provide> refill authorization.); and

prompting the physician or other user to dispatch the indication of approval and corresponding comments, if any, to the requesting pharmacy (Same reasons as provided above for the rejection of the previous two "prompting..." steps.)

Kobylevsky fails to explicitly disclose the step of:

prompting the physician or other user for the confirmation that the requested prescription is compatible with other medications, if any, prescribed to the patient;

However, this step is well known in the art as evidenced by the teachings of Goetz.

Goetz teaches a system that checks a drug about to be prescribed for potential interactions with other drugs (which would include drugs already prescribed to the patient), then prompts for confirmation whether or not to go

Art Unit: 3626

ahead and prescribe the medication should potential interactions be discovered (Goetz: col 11, 29-39; Figs 23 and 24).

The motivation to combine the teachings of Goetz within the method of Kobylevsky are the same as provided for claim 1 and is incorporated herein.

H. As per claims 22 and 23, they are system claims which repeat the same limitations of claims 1 and 6, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings Kobylevsky and Goetz disclose the underlying process steps that constitute the methods of claims 1 and 6, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 22 and 23 are rejected for the same reasons given above for claims 1 and 6.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art disclose automated methods and systems for generating and fulfilling medication prescriptions (US Pat#s 6,032,155, 5,845,255, 4,766,542, 5,935,060).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone

Art Unit: 3626

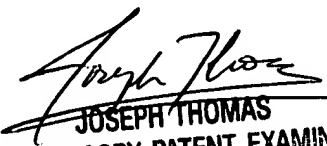
number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MG
7/09/2005


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